

touch screen panel; (3) a program key, a reset/preheat key, and an interrupt key located above the numeral keys and the enter key; (4) a trial copy key located beneath the interrupt key and on the right-hand side of the numeral keys and the enter key; (5) a set/counter key located on a top left-hand side of the touch screen panel; and (6) a copy key, a copy server key, and a printer key located below the set/counter key.

Regarding the rejection of Claim 11 under 35 U.S.C. § 103(a), the Office Action states that the '851 patent discloses all of the elements of Claim 11 with the exception of an enter key, a program key, a trial copy key, a copy key, a copy server key, and a printer key, as well as the positions of the function keys relative to each other. Further, the Office Action states that the '029 patent discloses the enter key, the program key, and the trial copy key; and that the '482 patent discloses the copy key, the copy server key, and the printer key. Moreover, the Office Action asserts that the relative location of the function keys is not relevant to the patentability of Claim 11,<sup>1</sup> and that the "soft" keys (on a touch panel display) disclosed by the '029 and '482 patents are equivalent to the claimed function keys.

The '851 patent is directed to an image processing apparatus that includes the keyboard/display device 3 shown in Figure 3. The '851 patent discloses a preheating key 56 and a counter key 62.<sup>2</sup> However, Applicants respectfully submit that those keys are not functionally equivalent to the claimed *set/counter* key and *reset/preheat* key respectively. The '851 patent fails to disclose that key 56 has a reset function, or that key 62 has a set function.

The '029 patent is directed to an image forming apparatus that includes the operation and display panel shown in Figure 6. The Office Action asserts that the trial copy start key

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<sup>1</sup>Office Action of June 5, 2002, at page 4, paragraph 3.

<sup>2</sup>'851 patent at Figure 3, and at column 4, lines 31-41.

72, shown in Figure 7, and the enter key 112, shown in Figure 9, read on the claimed trial copy key and the claimed enter key, respectively. However, the '029 patent discloses that keys 72 and 112 are displayed within the display 68, and are not separate mechanical keys. Moreover, a comparison of Figures 7 and 9 indicates that keys 72 and 112 are *not always available* in the display 68. The enter key 112 is used only in the "tab copy mode" of Figure 9, and does not function as a general purpose enter key located on the right-hand side of a touch screen panel. Thus, contrary to the assertion in the Office Action, Applicants respectfully submit that a "soft" key and mechanical key are not "interchangeable" if the functionality and/or availability of the key is altered.

The '482 patent is directed to an image forming system that includes the operation panel shown in Figure 3. Note however that the copy, file, and printer keys shown in Figure 3 are part of the touch screen panel, and are not located outside of the touch screen panel.

Thus, no matter how the teachings of the '851, '029, and '482 patents are combined, the combination does not teach or suggest all of the function keys recited in Claim 11. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 11 should be withdrawn.

Further, Applicants respectfully submit that there is no motivation to combine the teachings of the '851, '029, and '482 patents. As stated in a recent decision by the Federal Circuit, In re Sang Su Lee:

The factual inquiry whether to combine references must be thorough and searching. It must be based on *objective evidence of record*. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.<sup>3</sup>

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<sup>3</sup>277 F.3d 1338, (Fed. Circuit) 61 USPQ.2d 1430. (Emphasis added.)

The Office Action fails to point to any evidence of record that one of ordinary skill in the art would have been motivated to select, from all available references, the teachings of the '029 and '482 patents in order to modify the '851 patent image processing apparatus. For example, there is no suggestion in any of the cited references that a trial copy soft key (disclosed in one of several possible screen displays in the '029 patent) should be added as a separate key outside of the touch screen panel in the apparatus of the '851 patent.

Thus, it is respectfully submitted that independent Claim 11 patentably distinguishes over the '851, '029 and '482 patents. Consequently in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Gregory J. Maier  
Registration No. 25,599  
Attorney of Record  
Surinder Sachar  
Registration No. 34,423



**22850**

(703) 413-3000  
Fax #: (703) 413-2220  
GJM:SNS:KMB:sy  
I:\atty\kmb\0557\05574557\05574557-recon.wpd